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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,033	03/20/2001	Hiroshi Sasaki	01154/LH	2754

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NEW YORK, NY 10017-2023

EXAMINER

COLON, CATHERINE M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,033

Applicant(s)

SASAKI ET AL.

Examiner

C. Michelle Colon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the communication received on March 20, 2001. Claims 1-30 are now pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites, "wherein said information resource corresponding to said URL as restored from said coded image is an information resource ***adapted to*** at least one of studying and analyzing the printed matter." [Emphasis added] It is unclear what functionality is intended by the recitation that the information resource is ***adapted to*** study or analyze printed matter. The intended functionality should be positively recited to avoid such ambiguity. For purposes of examination, the Examiner is interpreting the recitation to simply mean the information resource provides the ability to study or analyze printed matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Perkowski (U.S. 6,064,979).

As per claim 1, Perkowski discloses a marketing research method for at least one of studying and analyzing a printed matter containing visually readable printed image including at least one of characters and photographic image and an optically readable coded image as obtained by encoding the URL to be used for specifying an information resource for the printed matter on World Wide Web connected to Internet by an access device, copies of the printed matter being distributed to one of specified and unspecified persons said method comprising the steps of:

storing access information obtained for each access to the information resource as a result of an operation of optically reading said coded image of a reading device, restoring said URL from the read coded image and accessing said information resource corresponding to the restored URL by said access device connected to said reading device (col. 3, lines 51-54; col. 5, lines 19-31; col. 10, lines 27-32 and 37-40; The system discloses a UPC number readable by a bar code scanner, the UPC number

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linking to a website when it is scanned. The website is an information resource that provides information related to the UPC number such as product information. The UPC and information resource data are stored in a relational database.); and

at least one of studying and analyzing the printed matter by utilizing the access information on the accesses as stored in said information resource (col. 14, lines 50-62; Users can study information related to a product accessed at a URL after scanning the product's UPC code.).

As per claim 2, Perkowski discloses the marketing research method according to claim 1, wherein said information resource corresponding to said URL as restored from said coded image is an information resource adapted to at least one of studying and analyzing the printed matter (col. 14, lines 50-62; The information resource provided by the URL enables users to study information related to a product accessed through the URL.).

As per claim 3, Perkowski discloses the marketing research method according to claim 2, wherein said URL includes ID information for identifying said printed matter (col. 18, lines 39-43 and 52-55; URLs and UPCs are linked so that they point to very specific information files on the web related to the products associated with the printed matter.).

As per claim 4, Perkowski discloses the marketing research method according to claim 3, wherein said ID information includes at least one of a name of the printed matter, a type of the printed matter, a date of distribution of copies of the printed matter, a distribution area of copies of the printed matter and a purpose of distribution of copies

of the printed matter as identifiable information (col. 10, lines 47-67; The ID information is associated with a variety of product information such as promotions, sales and distribution of the product.).

As per claim 5, Perkowski discloses the marketing research method according to claim 1 wherein said URL includes ID information for identifying said printed matter (col. 18, lines 39-43 and 52-55; URLs and UPCs are linked so that they point to very specific information files on the web related to the products associated with the printed matter.).

As per claim 6, Perkowski discloses the marketing research method according to claim 5, wherein said ID information includes at least one of a name of the printed matter, a type of the printed matter, a date of distribution of copies of the printed matter, a distribution area of copies of the printed matter and a purpose of distribution of copies of the printed matter as identifiable information (col. 10, lines 47-67; The ID information is associated with a variety of product information such as promotions, sales and distribution of the product.).

As per claim 7, Perkowski discloses the marketing research method according to claim 1, wherein said coded image further contains a browser starting program for starting a browser for said access device (col. 6, lines 19-25; col. 7, lines 6-14).

As per claim 8, Perkowski discloses the marketing research method according to claim 1, wherein said printed matter is one of a newspaper, a magazine, a book, a journal, a pamphlet, a catalog, a leaflet and a ticket (col. 10, line 29; col. 13, lines 4-5 and 20-28).

As per claim 9, Perkowski discloses the marketing claim 1, wherein research method according to if said printed matter carries at least one of a plurality of articles and advertisements and the at least one of each article and each advertisement shown on the printed matter is provided with a printed coded image, the URL contained in each of the coded images includes ID information for identifying the at least one of the article and the advertisement, whichever appropriate (col. 12, lines 41-48; col. 13, lines 4-5 and 20-38; The system links the ID information to the appropriate URL. For example, if the ID information is for a ticket to an event, the URL links to information related to the event.).

As per claim 10, Perkowski discloses the marketing research method according to claim 1, wherein said information resource is an information resource belonging to the issuer of the printed matter (col. 10, lines 37-40; The information resources can link to information related to manufacturers of a product related to the UPC and URL.).

As per claim 11, Perkowski discloses the marketing research method according to claim wherein a plurality of printed matters containing a same advertisement is involved and the advertisement of each of the printed matters is accompanied by a coded image specific to the printed matter, said information resource is an information resource belonging to the sponsor of the advertisement (col. 12, lines 24-28 and 54-62).

As per claim 12, Perkowski discloses the marketing research method according to claim 1, wherein the access information on the accesses to the information resource includes at least one of number of accesses, date and time of each of the accesses and

data on each of persons who accessed (col. 13, lines 20-38; The UPC data can demark service related information such as attendance to an event.).

As per claim 13, Perkowski discloses the marketing research method according to claim 1, wherein said coded image includes information on at least one of a sound, an image and a text in addition to said URL (col. 14, lines 50-62; The URL links to text related to the product associated with the UPC.).

Claims 14-30 recite substantially similar subject matter as claims 1-13 above. Therefore, claims 14-30 are rejected on the same basis as claims 1-13 above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Perkowski (U.S. 5,950,173) discusses a method for delivering consumer data over the Internet;
- Golden et al. (U.S. 5,761,648) discusses an interactive marketing network; and
- Simons et al. (U.S. 6,230, 143) discusses a system for analyzing coupon redemption data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-

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4251. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 [Official Communications; including After Final communications labeled "Box AF"]

703-746-7202 [For status inquiries, draft communication, labeled "Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA 7th floor receptionist.

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER
Au 3623

PMC
cmc

February 4, 2005